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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,304	01/02/2002	Conley W. Giles	13471:11	2149

7590 06/24/2003

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[REDACTED] EXAMINER

FOSTER, JIMMY G

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3728

DATE MAILED: 06/24/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 10/039,304	Applicant(s) Giles et al.
Examiner Jimmy G. Foster	Art Unit 3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-46 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-46 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2,3

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

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1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 9-35 and 37-46 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bussey, Jr et al (5,766,771).

In the patent of Bussey, Jr et al the insulation barrier 12 defines a foam structure/structural unit because it includes a substrate 16 made of polyethylene foam (col. 4, lines 3-5). The foam will define a first part. The insulation also includes a film which may define a second part of the insulation. The facing sides of the first and second parts come into contact

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with each other. The foam is intended to function as an insulating material **component** in structures such as **buildings**.

The insulation, which also includes the film 17, overlaps with adjacent panels of insulation and therefore is combined with said adjacent panels or windings (col. 4, lines 3-63). In addition, the insulation becomes combined with a wood element (col. 5, lines 30-31.)

Orifices in the insulation 12 permit wall connection to a building wall using fasteners such as staples 21 (see Figs 2, 5 and 6) which interlock with the insulating panel and with the other material of the building. The staples may be considered to define an additional material, as set forth in instant claim 23. The orifices for the stapes may be considered to define conduits for the passage of the interlocking staples 21.

In addition there are provided orifices 19 which may be considered to define conduits for the passage of a fluid (of air or moisture). Further, such orifices 19 would be inherently capable of passing electrical conductors. Inasmuch as the claims do not call for the conductors in a structural sense, the capability of the orifices of Bussey, jr et al to pass conductors meets what is claimed.

In the embodiment described in column 6, lines 8-67 the substrate 16 includes a plurality of spaced apart embossments. Such spaced apart embossments would inherently be capable of interlocking with a second element, such as a foam, concrete or wood element, having appropriately formed mating embossments capable of being received in the spaces between the substrate embossments. Inasmuch as the claims (1-5) do not positively recite the element as structure but as intended use, such a

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capability meets the limitations regarding interlocking with a foam concrete or wood element.

The side of the foam structure with the embossments is formed to protect the packaged product (such as a piece of furniture, see col. 6, lines 37-38 and lines 41-45). The embossments contact the product (col. 6, lines 47-54). Moreover, the foam structure is used as a building material (see for example col. 6 lines 17-20).

Regarding claim 14 which calls for a disassociation of first and second parts, the Bussey, Jr et al patent discloses that sections of the insulation 12 may be cut out over door and window openings. Regarding the limitation calling for the joining of the first part to an element so as to define a structural unit that is used as a building material, insulation 12 of Bussey, Jr et al is joined with the studs of a building and therewith define a composite building material therewith.

Regarding claim 17 which calls for the structural unit to float, the insulation 12 of Bussey, Jr et al will float because of the floatability of the foam substrate 16 thereof. Also see column 7, lines 1-4) The substrate/structural unit together with the film may be considered to define a flotation product insofar as claimed.

Regarding claim 18 which calls for the unit to be a portion of a wall form for a pourable building material, the building wall disclosed by Bussey, Jr et al which incorporates the insulation 12, is capable of receiving a pourable building material.

Regarding claims 21 and 23 which fail to recite as structure the adhesive securement or interlock of the unit with

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another foam unit, such is being claimed instead as intended use. The insulation 12 of Bussey, Jr et al is capable of being adhesively attached or interlocked to an adjacent panel of insulation. Moreover, the film 17 of the insulation 12 of Bussey, Jr et al overlaps an adjacent winding of insulation and may be adhesively attached thereto (col. 4, lines 48-63).

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bussey Jr, et al (above) in view of Vilas-Boas (5,060,801). The patent to Vilas-Boas, at column 2, line 67 through column 3, line 13 and Figures 6a and 6b, suggests that protective packaging foam structures 1 (called bolsters) may interlocked with other foam structures within a container for compact storage. Accordingly, it would have been obvious in view of Vilas-Boas to have interlocked plural foam structures 12 of Bussey, Jr et al for the purpose of compactly storing the structures. The patent to Vilas-Boas further suggests that a container (50) may receive a number of the foam structures in a plurality of volumes limited by the plates 53-55 and that three foam structures may be placed in the portion below plate 53 (see Figure 6b). Knowing that the volume of the container will limit the number of stored structures to be stored therein inherently

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constitutes counting a capacity count when the container is full. Moreover, Figure 6b inherently teaches a count of three foam structures. Accordingly, it would have further been obvious to have counted said stored foam structures 12 of Bussey, Jr et al while storing them for the purpose of knowing how many are stored.

6. Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bussey, Jr et al (above) in view of Fiechtl (6,189,279). The patent to Fiechtl at 12,14,18 and 20 column, line 12 and column 2, lines 11-55 suggests that providing a concrete floor (14) base with sub-layer (12) made of foam and film will prevent moisture damage to the upper floor treatments in a floating floor system. The reference further suggests that the foam should be made of open-celled vinyl instead of polyethylene for the purpose of preventing dead spots. Accordingly it would have been obvious in view of Fiechtl to have employed the insulation material 12 of Bussey, Jr et al as a sub-flooring over concrete, with the exception that the foam being an open-celled foam in the manner of Fiechtl for the purpose of preventing dead spots.

7. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --  
Customer Service. . . (703)306-5648  
\*\*\*

For matters regarding examination -- Examiner:  
Jim Foster . . . . . (703)308-1505  
\*\*\*

For faxing of correspondence:  
DRAFT Fax amendments only-(703)308-7769  
(Examiner should be notified of fax)

FORMAL Fax correspondence-(703)305-3579 or 305-3580

RIGHT FAX- Before Final . . (703) 872-9302

Serial Number: 10/039,304

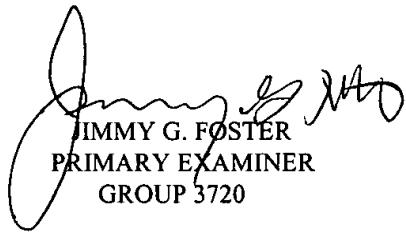
-7-

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After Final . . . (703) 872-9303  
(The examiner ordinarily will not retrieve  
formal correspondence)  
\*\*\*

For petitions:

Before the Examiner . (703)308-1505  
Before the Group Director . (703)308-3872  
Other petitions . . . (703)305-9282



JIMMY G. FOSTER  
PRIMARY EXAMINER  
GROUP 3720

JGF  
June 23, 2003